

REMARKS

This Amendment and Request for Reconsideration is submitted in response to an outstanding Office Action dated July 28, 2005, the shortened statutory period for response set to expire on **October 28, 2005**. Accordingly, applicants submit that this response is timely submitted and that no extension of time or fee is due. In the event that the Commissioner determines that an extension of time or fee is due, the undersigned hereby petitions for such extension and authorizes the Commissioner to charge any required fee to the Milbank deposit account 13-3250.

I. Status of the Claims

Please amend claims 1, and 5-7 and add new claims 8 - 16 as indicated above. Claims 1-16 are now pending in the application. Claims 1 and 5-7 are independent claims.

Support for the new claims is found in the specification at for example: paragraph [0021] claim 8, paragraph [0024] claim 9, paragraphs [0019] and [0031] claim 10, paragraph [0031] claim 11, paragraph [0028] claim 12, paragraph [0019] and [0028] claim 13, paragraph [0020] claim 14, paragraph [0022] claim 15, and paragraph [0024] claim 16. Applicants acknowledge the Examiner's citation of statutory authority as a basis for claim rejections.

II. Rejections under 35 U.S.C. § 101

Applicant thanks the examiner for withdrawing the previous rejection of claim 6 under 35 U.S.C. § 101. The Examiner has maintained the rejection of claim 5 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner states that “the claimed process must be limited to a practical application of the abstract idea of mathematical algorithm in the technological art. However, ‘information signal’ recited in claim 5 is not tangible. Specification failed to provide antecedent basis for ‘information signal’ recited in claim 5, it

appears that information signal is not linked to tangible embodiment, therefore non-statutory.”

In the response of May 11, 2005, applicant amended the specification to provide antecedent bases for the information signal of claim 5. As previously argued, applicant submits that in software sale and distribution, code for accomplishing a method may be sold and distributed on a computer readable medium (*e.g.*, claim 6) for later installation on a computer system. It is also common for software code to be distributed directly to users by electronic down-load to a computer, without transfer of a computer readable medium. In order to fully protect the various types of sales and distribution activities, applicants have crafted claims to specifically cover electronic transfer of infringing software code, by directing claim 5 to computer software code **transmitted as an information signal**. Applicants submit that computer executable software code transmitted as an information signal (claim 5) serves a useful purpose just as a computer readable medium (claim 6), and a computer with memory and a processor (claim 7) serve useful purposes. Applicant submits that to be statutory, 35 U.S.C. § 101 requires nothing more. For this reason, applicant requests withdrawal of the rejection of claim 5.

Applicant also directed the Examiner’s attention to claims 84, 85 and 86 of U.S. Patent No. 6,513,020, which issued on January 28, 2003 (“the ‘020 patent”). Those claims are directed to “A computer data signal embodied in a carrier wave and representing instructions for execution by a computer for ...” Applicant’s also direct the Examiner’s attention to claims 82 and 83 of the ‘020 patent. Those claims are directed to a computer program product for ... comprising: a computer readable medium having stored thereon ...” Applicants submit that there is no statutory difference between the subject matter of claims 82 through 86 of the ‘020 patent and claim 5 of the instant application.

Finally, Applicant directs the Examiner's attention to recent holdings from the Court of Appeals for the Federal Circuit, which clearly show that software code alone is patentable as a process, and that electronic transmission of software code is eligible for the same protection as a physical media where the software code is stored. In *Eolas*, the Federal Circuit stated that "[w]ithout question, **software code alone qualifies as an invention eligible for patenting ... at least as processes.** ... [T]his software code claimed in conjunction with a physical structure, such as a disk, fits within at least these ... categories of subject matter within the broad statutory label of 'patented invention.'" *Eolas Tech. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1399 (Fed. Cir. 2005) (emphasis added). In *A T & T*, the Federal Circuit quoted *Eolas* for that proposition, and then stated "we cannot accept [the] suggestion that **software sent by electronic transmission must be treated differently** for purposes of § 271(f) liability **from software shipped on disks**, ... as it would amount to an exaltation of form over substance. [W]hether software is sent abroad via **electronic transmission or shipped abroad on a ... disk is a distinction without a difference** for the purposes of § 271(f) liability." *A T & T Corp. v. Microsoft Corp.*, No. 04-1285, 2005 WL 1631112, *4 (Fed. Cir.(S.D.N.Y) July 13, 2005) (emphasis added).

Withdrawal of the rejection of claim 5 under 35 U.S.C. § 101 is respectfully requested.

III. Rejections under 35 U.S.C. § 112

The Examiner has rejected claims 1 and 5-7 under 35 U.S.C. § 112 ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner states that "[i]t is unclear who is creating token. For the purposes of the examination examiner assumes server creates token."

Applicant respectfully traverses the rejection, and does not agree with the Examiner's assumption that the server creates the token.

Claim 1 recites: sending a first request from a client to a server; [and] responsive to the first request, initiating a request by the server to create a token. Claim 1 also recites: determining at the first link whether the token is created. Claims 5-7 include similar language.

Applicant submits that the language of claims 1 and 5-7 particularly point out and distinctly claim the subject matter that applicant regards as the invention. Applicant submits that there is a request by the server to create a token. There is also a determination at the first link whether the token is created. Claims 1 and 5-7 are silent as to where the token is created and applicant submits that the claims need not state where the token is created to satisfy the requirements of § 112. However, to assist the Examiner in understanding where a token might be created, applicant has added new dependent claims 10 and 11, which specify where a token is created. Thus, it should be clear to the Examiner that Applicant has not limited where the token is created in claims 1 and 5-7, merely reciting a request by the server to create a token. Applicant submits that the rejection under § 112 is not supported and request withdrawal of the rejection.

IV. Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1, and 5 - 7 under 35 U.S.C. § 102 as being anticipated by *Montulli* (U.S. Patent No. 6,134,592).

In the rejection, the Examiner states that *Montulli* discloses “sending a first request from a client to a server (Column 7, lines 35-36, Montulli discloses request from client to server); responsive to the first request, initiating a request by the server to create a token (Column 7, lines 35-36, Montulli discloses creating token); responsive to the first request, sending information from the server to the client, the information including at least display data and a

first link corresponding to the token (Column 7, lines 21-25, lines 36-40 Montulli discloses link corresponding to the token); rendering the display data in a browser of the client (Column 7, lines 40-43, Montulli discloses rendering the display data in a browser); sending a second request from the client to the first link (Column 7, lines 45-50, Montulli discloses sending second request); determining at the first link whether the token is created; and (Column 7, lines 21 -25, Column 8, lines 21 -22, Montulli discloses determining if token is created) if the token is created, sending the token to the client. (Column 8, lines 21-24, Montulli discloses sending token to the [client]).”

Applicant respectfully traverses the rejection under § 102.

Applicant first notes that claim 1 states (emphasis added): initiating a request by the server to create a token; responsive to the first request, sending information from the server to the client, the information including at least display data and a first link corresponding to the token but not including the token; rendering the display data in a browser of the client; sending a second request from the client to the first link, the second request not including the token; determining at the first link whether the token is created; and if the token is created, sending the token to the client.

Applicant understands that the Examiner is equating the header of *Montulli* with the claimed first link, the cookie of *Montulli* with the claimed token, and the HTML document of *Montulli* with the claimed information. If this is correct, then applicant submits that *Montulli* discloses conventional use of a cookie by: receiving a first client request at a server, creating a cookie, returning the cookie to the client in the header, and sending the requested information to the client in an HTML document. As applicant understands *Montulli* and the conventional use of cookies, there is no disclosure of sending a header as a link corresponding to a cookie, where the header does not include the cookie.

As stated in the specification, an objective of the invention is to allow a client to timely receive requested information from a server without an included token or cookie, where creation of the token or cookie may require additional time, and then arrange to send the token or cookie to the client after it is created. As the claims recite, this is accomplished by receiving the client request, returning the requested information with a link that corresponds to the token, but not including the token, and at a later time after the token is created, sending the token to the client.

Accordingly, applicant submits that *Montulli* does not teach or suggest all of the elements of claims 1, and 5-7, and therefore the rejection of those claims over *Montulli* is overcome, and asks the Examiner to withdraw the rejection.

V. Rejections under 35 U.S.C. § 103

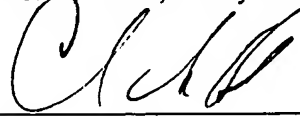
The Examiner has rejected claims 2-4 under 35 U.S.C. § 103 as being unpatentable over *Montulli* in view of *Sato* et al. (U.S. Patent No. 6,718,482).

As discussed above, Applicants submit that because claim 1 is allowable over *Montulli*, dependent claims 2-4 are allowable over *Montulli* in view of *Sato*, and respectfully ask the Examiner to withdraw the rejection.

VI. Request for Reconsideration

Applicants respectfully submit that the claims of this application are in condition for allowance. Accordingly, reconsideration of the rejection and allowance is requested. If a conference would assist in placing this application in better condition for allowance, the undersigned would appreciate a telephone call at the number indicated.

Respectfully submitted,
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